

Appl. No. : 10/820,381
Filed : April 8, 2004

REMARKS

In the October 17, 2005 Office Action, the Examiner rejected Claim 1-4 and 42-43 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2003-0141919 by Wang, et al ("Wang"). Applicants request reconsideration of the rejections in view of the foregoing amendments and the following comments.

For the purposes of responding to the Office Action, Applicants will treat the cited reference as prior art, but Applicants reserve the right to swear behind the reference in the future and reserve the right to remove the reference under common ownership in the future.

Information Disclosure Statement

Applicants are filing an Information Disclosure Statement concurrently with the filing of this response.

Formal Drawings

Applicants are submitting formalized drawings (without amendment) with the filing of this response.

Common Ownership

Applicants note that Wang would not be a proper reference to the present application under 35 U.S.C. § 103(a) due to common ownership.

See M.P.E.P. 706.02(l)(1) citing 35 U.S.C. § 103(c), "*Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.*"

The present patent application and the Wang patent application, at the time the invention of the present application was made, were owned by PMC-Sierra, Inc. An assignment for the Wang patent application is recorded at Reel 012806 and Frame 0592 and lists the operations headquarters of PMC-Sierra Ltd as the assignee. The present patent application is recorded at Reel 014832 and Frame 0022 and lists the corporate head office of PMC-Sierra, Inc. as the assignee.

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Amendments to Claims 1 and 42

The Examiner rejected independent Claims 1 and 42 under 35 U.S.C. § 102(e) as being anticipated by Wang. In response to the Examiner's rejection, Applicants have amended independent Claims 1 and 42 to recite that the claimed invention comprises "at least part of a state machine." This added limitation is supported by, for example, paragraph [0161].

Applicants respectfully submit that Wang does not teach or suggest a state machine, let alone a state machine with the active loads as claimed in Claims 1 or 42. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," see MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Therefore, Applicants respectfully request the Examiner to withdraw the rejections of Claims 1 and 42, and Applicants request allowance of the same.

Dependent Claims 2-4 and 43

Dependent Claims 2-4 and 43 depend from and further define Claims 1 and 42, respectively. The dependent claims recite numerous additional distinctions over the cited references and are distinguishable for at least the reasons described for Claims 1 or 42.

Accordingly, Applicants request allowance of Claims 2-4 and 43.

New Dependent Claims 44-48

Applicants have added new dependent Claims 44-48 herein to further define the invention as claimed. Claims 44-47 depend from and further define Claim 42. Claim 48 depends from and further defines Claim 1. These claims are supported by, for example, paragraphs [0161] and/or [0164]. The dependent claims recite numerous additional distinctions over the cited references, and Applicants request allowance of the same.

Rejoinder of Dependent Claims 5-17

Dependent Claims 5-17 depend from and further define Claim 1 or intervening claims thereof. In view of the patentability of amended Claim 1 or intervening claims, Applicants request rejoinder of previously withdrawn Claims 5-17 as discussed in M.P.E.P. 821.04(a). Dependent Claims 5-17 include all the limitations of at least Claim 1.

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Rejoinder of Claims 18-41

Applicants have amended independent Claims 18, 21, 22, 29, and 34 to recite that the claimed invention comprises "at least part of a state machine." The status identifier of "Withdrawn-currently amended" is permitted under 37 C.F.R. § 1.121(c)(2). Claims 19-20 depend from and further define Claim 18. Claims 23-28 depend from and further define Claim 22 or intervening claims thereof. Claims 30-33 depend from and further define Claim 29. Claims 35-41 depend from and further define Claim 34 or intervening claims thereof.

Applicants respectfully submit that amended Claim 42 is generic over the species claimed in amended Claims 18, 21, 22, 29, and 34 and their dependents. In view of the patentability of amended Claim 42, Applicants request rejoinder and allowance of previously withdrawn Claims 18-41 as discussed in M.P.E.P. 821.04(a)

Applicants reserve the right to pursue any of Claims 18, 21, 22, 29, and 34 in a future divisional or other continuing applications in a form without the amendments made in this paper.

SUMMARY

In view of the foregoing amendments and remarks, Applicants respectfully request the Examiner to withdraw the rejections of Claims 1-4 and 42-43 under 35 U.S.C. § 102(e). Applicants further request the Examiner to allow Claims 1-4 and 42-43, to rejoin and allow previously withdrawn Claims 5-41, to allow new Claims 44-48, and to pass the present application to the issue process.

If there is any further impediment to the prompt allowance of the present application, Applicants request the Examiner to call the undersigned attorney of record at 310-407-3466 or at the telephone number listed below to resolve any such impediment.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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